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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/650,018

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Hubert Kaffl

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02/03/2006

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EXAMINER

MIGGINS, MICHAEL C

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/650,018	<b>Applicant(s)</b> KAFFL ET AL.	
	<b>Examiner</b> Michael C. Miggins	<b>Art Unit</b> 1772	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 6-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6-13 and 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### **REJECTIONS WITHDRAWN**

1. The 35 USC 112 2<sup>nd</sup> paragraph rejection set forth in the non-final rejection of 6/6/05, page 4, paragraphs 9-10 has been withdrawn. The 35 USC 102(b) and 103(a) rejections set forth in the non-final rejection of 6/6/05, pages 4-7, paragraphs 11-17 have been withdrawn.

### **REJECTIONS REPEATED**

2. There are no rejections repeated.

### ***Examiner's comments***

3. Claim 17 is an improper independent claim because it fails to recite all of the claim limitations of claim 1 which claim 17 tries to incorporate by reference. An independent claim must recite all the limitations for which applicant seeks coverage and may not incorporate limitations by reference to another claim. The dependencies of claim 16 is improper because claim 8 has been canceled. The dependencies of claims 18-20 are improper because claim 10 mentions nothing of pressure marks. However, it is believed that the dependencies of claims 18-20 are type-o's. For purposes of examination claims 18-20 are construed to depend from claim 17 which deals with markings. Claims 7 and 10 contain the term "preferably" which should be removed so as to avoid possible indefinite issues.

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## **NEW REJECTIONS**

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claim 21 is rejected under 35 U.S.C. 102(a) as being anticipated by Laux (WO 01/62489) and Laux (US 2003/0113492, cited only as the English translation of WO 01/62489).

Laux discloses a patch comprising a packaging surface element for adhesive goods or goods containing adhesive means, wherein the packaging surface element has a non-adhesive coating on its inner wall (see English abstract of WO 01/62489 and page 2, paragraphs [0016] – [0023]) of US 2003/0113492).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1, 6-7 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laux (WO 01/62489) and Laux (US 2003/0113492, cited only as the English translation of WO 01/62489) in view of Ebbrecht et al. (US 5494979).

Adhesive is the same as non adhesive.

Laux discloses a patch comprising a packaging surface element for adhesive goods or goods containing adhesive means, wherein the packaging surface element has a non-adhesive coating on its inner wall (see English abstract of WO 01/62489 and page 2, paragraphs [0016] – [0023]) of US 2003/0113492), wherein the non-adhesive coating is a sealable coating (since the coating can be a fluoroethylene which are sealable, page 2, paragraph [0023] of 2003/0113492), wherein the sealable material is a polyethylene (page 2, paragraph [0023] of 2003/0113492), wherein the non adhesive coating is based on a silicone (page 2, paragraph [0023] of 2003/0113492), wherein the non-adhesive is based on at least one halogenated hydrocarbon polymer (page 2, paragraph [0023] of 2003/0113492) (applies to instant claims 1, 6-7 and 10-11).

Laux fails to disclose the non-adhesive coating having a non-adhesive agent based on silicone or PDMS.

Ebbrecht discloses a non-adhesive coating having a non-adhesive agent based on silicone or PDMS (abstract, column 13, lines 42-62) for the purpose of providing improved non adhesiveness, or abhesiveness (applies to instant claims 1, 6-7 and 10-11).

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Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided the non-adhesive coating having a non-adhesive agent based on silicone or PDMS in the non adhesive coating of Laux in order to provide improved non adhesiveness, or abhesiveness as taught or suggested by Ebbrecht.

8. Claims 12-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanios (US 2001/0048987) in view of Laux (WO 01/62489) and Laux (US 2003/0113492, cited only as the English translation of WO 01/62489) and Ebbrecht et al. (US 5494979).

Kanios a packaged transdermal system wherein the system comprises a transdermal system comprising a support layer, a matrix and a covering layer, top and bottom (11 from Fig. 1) and is sealable (page 3, paragraphs [0034] – [0036]), wherein the matrix is selected from the group consisting of a self adhesive matrix and a matrix with an adhesive (page 2, paragraph [0029]) (applies to instant claims 12-13 and 15-16).

Kanios fails to disclose a sealable non adhesive coating having a non adhesive agent.

Laux discloses a patch comprising a packaging surface element for adhesive goods or goods containing adhesive means, wherein the packaging surface element has a non-adhesive coating on its inner wall (see English abstract of WO 01/62489 and page 2, paragraphs [0016] – [0023]) of US 2003/0113492), wherein the non-adhesive coating is a sealable coating (since

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the coating can be a fluoroethylene which are sealable, page 2, paragraph [0023] of 2003/0113492) in order to prevent the patch from sticking to the container (applies to instant claims 12-13 and 15-16).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided a sealable non adhesive coating in the system of Kanios in order to prevent the patch from sticking to the container as taught or suggested by Laux.

Ebbrecht discloses a non-adhesive coating having a non-adhesive agent based on silicone or PDMS (abstract, column 13, lines 42-62) for the purpose of providing improved non adhesiveness, or abhesiveness (applies to instant claims 12-13 and 15-16).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided the non-adhesive coating having a non-adhesive agent based on silicone or PDMS in the non adhesive coating of Kanios in order to provide improved non adhesiveness, or abhesiveness as taught or suggested by Ebbrecht.

With regard to claim 15 it would have been obvious to have provided a folded pouch with only one end seam in order to provide ease of construction especially since layer 11 of Kanios is self sealable (page 3, paragraphs [0034] – [0036]).

9. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laux (WO 01/62489) and Laux (US 2003/0113492, cited only as the English

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translation of WO 01/62489) in view of Ebbrecht et al. (US 5494979) and Sprehe et al. (US 6361212).

Abhesive is the same as non adhesive.

Laux discloses a patch comprising a packaging surface element for adhesive goods or goods containing adhesive means, wherein the packaging surface element has a non-adhesive coating on its inner wall (see English abstract of WO 01/62489 and page 2, paragraphs [0016] – [0023]) of US 2003/0113492), wherein the non-adhesive coating is a sealable coating (since the coating can be a fluoroethylene which are sealable, page 2, paragraph [0023] of 2003/0113492), wherein the sealable material is a polyethylene (page 2, paragraph [0023] of 2003/0113492), wherein the non adhesive coating is based on a silicone (page 2, paragraph [0023] of 2003/0113492), wherein the non-adhesive is based on at least one halogenated hydrocarbon polymer (page 2, paragraph [0023] of 2003/0113492) (applies to instant claims 1, 6-7 and 10-11).

Laux fails to disclose the non-adhesive coating having a non-adhesive agent based on silicone or PDMS.

Ebbrecht discloses a non-adhesive coating having a non-adhesive agent based on silicone or PDMS (abstract, column 13, lines 42-62) for the purpose of providing improved non adhesiveness, or abhesiveness (applies to instant claims 1, 6-7 and 10-11).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided the non-adhesive coating having a non-adhesive agent based on silicone or PDMS in the non



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adhesive coating of Laux in order to provide improved non adhesiveness, or abhesiveness as taught or suggested by Ebbrecht.

Laux fails to disclose the use of pressure marks on the package surface element.

Sprehe discloses the use of marks on a polymeric substrate (Fig. 5, #3, column 3, lines 13-25). Sprehe discloses the use of marks (which broadly encompasses colored marks) for the purpose of providing marks or other machine readable indicia thereon the permit an electric eye or the like to read the marks and achieve proper registration and alignment of two portions of a bag (applies to instant claims 17-20).

It would have been obvious to one of ordinary skill in the art to combine Laux and Sprehe since each discloses sealed packages.

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided pressure marks on the package surface element in order to ensure proper registration of the package during sealing.

### **ANSWERS TO APPLICANT'S ARGUMENTS**

10. Applicant's arguments filed 1//3/05 have been considered but are moot in view of the new grounds for rejection set forth above.

### ***Conclusion***

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is 571-272-1494. The examiner can normally be reached on 1:00-10:00pm.

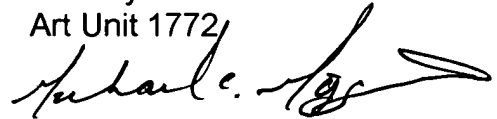
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCM  
January 23, 2006

Michael C. Miggins  
Primary Examiner  
Art Unit 1772

A handwritten signature in black ink, appearing to read "Michael C. Miggins", with a stylized flourish at the end.